

REMARKS

As a result of the foregoing amendments, Claims 26 and 63 have been amended to limit the oligonucleotides to a maximum length of 17 nucleotides, withdrawn Claims 55-62 have been canceled and all withdrawn subject matter has been removed from Claims 26, 32 and 33. No new matter has been entered as a result of this amendment. The limitation added to Claims 26 and 63, that the oligonucleotide has a maximum length of 17 nucleotides, is supported throughout the specification and in Claim 1, as originally filed.

Entry of these amendments and reconsideration of pending claims 26-34, 41-54 and 63 are respectfully requested. Entry of these amendments after the final Office Action is appropriate because they place the application in condition for allowance, or, at the very least, reduce the number of issues for appeal. In particular, these amendments remove all withdrawn subject matter and claims from the application. The amendments also replace the limitation "a length of 7 to 17 nucleotide units", that was the cause of the 35 U.S.C. §112 rejection, with "a maximum length of 17 nucleotide units" as suggested by the Examiner on page 5 of the final Office Action. Furthermore, Claim 63 has been amended to specifically limit the oligonucleotides claimed to a maximum of 17 nucleotides, which overcomes the 35 U.S.C. §103 rejection, because the prior art cited specifically requires a minimum of 18 nucleotides. Accordingly, entry of these amendments after a final Office Action is respectfully requested and proper.

Pending Claims Meet Requirements of 35 U.S.C. §112

Reconsideration and withdrawal of the rejection of claims 26-34 and 41-44 as being indefinite under 35 U.S.C. § 112, second paragraph, are respectfully requested. The claim limitation identified in the rejection as being unclear (the oligonucleotides having "a length from 7 to 17 nucleotide units") has been replaced according to the Examiner's suggestion with the limitation "wherein the oligonucleotide has a maximum length of 17 nucleotide units." Accordingly, this rejection has been overcome.

Claim 63 is Not Obvious Over Denner in view of Baracchini and Friesen

Applicants respectfully request reconsideration and withdrawal of the rejection of claim 63 under 35 U.S.C. §103(a) as being unpatentable over Denner in view of Baracchini et al and Friesen et al. Denner fails to teach the limitation of claim 63 that the oligonucleotide is of 17 or fewer

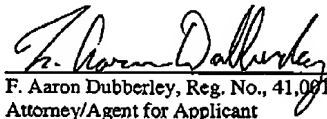
nucleotides in length. In fact, Denner specifically teaches on pages 3, 4, 9 and 12 that an antisense oligonucleotide targeted against the same region of the tenascin gene as the instantly claimed oligonucleotides must be at least 18 nucleotides in length. Although Baracchini et al and/or Friesen et al may teach antisense oligonucleotides to other targets that are 17 or fewer bases in length, neither of these generic references would motivate one of skill in the art, who knows the unpredictability of antisense oligonucleotide effectiveness, to disregard the teaching of Denner that antisense oligos targeted to this region of tenascin must be of at least 18 nucleotides in length.

The combined prior art also fails to teach or suggest other limitations of instant Claim 63. Denner fails to teach the specific patterns of backbone modification to SEQ ID Nos: 21 through 30, as claimed in Claim 63. Nothing in either Baracchini et al and/or Friesen et al remedy this deficiency in Denner. Accordingly, the combination of prior art cited by the rejection does not teach or suggest, to one of skill in the art, all the limitations of Claim 63.

Applicants acknowledge the Examiner's statement that claims 45-54 are free of the prior art.

Applicants respectfully submit that the application is now in condition for allowance and request prompt notice thereof.

Respectfully submitted,


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Aventis Docket No. DEA V1997/L238 US PCT